



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,827	08/06/2003	Gary M. Zelman	03-07-2102	7689

23388 7590 09/03/2004

TROJAN LAW OFFICES
9250 WILSHIRE BLVD
SUITE 325
BEVERLY HILLS, CA 90212

EXAMINER

DANG, HUNG XUAN

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,827

Applicant(s)

ZELMAN, GARY M.

Examiner

Hung X Dang

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Information Disclosure Statement

1. The Information disclosure Statements filed on 5/7/04 has been considered.

Claims Rejection Under 35 USC - 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Chao** (6,109,747).

Chao discloses eyeglasses frame with magnets in flanges which comprises a primary lens frame 10 having a first pair of lens holders for holding a pair of primary lenses 90 and separated by a bridge portion 11, said bridge portion 11 having a major magnetic member 14 positioned on rear side such that a surface of the major magnetic member is exposed and faces rearward, said major magnetic member 14 magnetically coupling to a minor magnetic member 26 in an auxiliary frame 20, thereby securing the auxiliary frame 20 to the primary lens frame 10 (see figures 1-3 and the related disclosure.)

Claims Rejection Under 35 USC - 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 14-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (6,109,747).

Chao discloses eyeglasses frame with magnets in flanges which comprises a primary lens frame 10 having a first pair of lens holders for holding a pair of primary lenses 90 and separated by a bridge portion 11, said bridge portion 11 having a major magnetic member 14 positioned on rear side such that a surface of the major magnetic member is exposed and faces rearward, said major magnetic member 14 magnetically coupling to a minor magnetic member 26 in an auxiliary frame 20, thereby securing the auxiliary frame 20 to the primary lens frame 10 (see figures 1-3 and the related disclosure.)

Chao discloses a grip extension 24 having a flange 25 downward with a magnet 26 whereas the claimed invention claims that a grip extension having a flange upward with a magnet.

The difference between the claimed invention and Chao is the flange. The flange of the claimed invention is upward whereas Chao discloses the flange is downward (see figures 1-3 and the relative disclosure.)

Although the Chao device does not teach the exact configuration as that claimed by Applicant, the configuration differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

It should be noted that although claims 18-26 are "method claims", the method steps consist of the broad steps of "constructing" and "coupling" etc and therefore these steps would be obvious satisfied by the apparatus of the reference as modified.

4. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

9/04



HUNG DANG

PRIMARY EXAMINER

TC 2800